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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/702,030

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Thomas L. Kelly

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EXAMINER

DREIDAME, HUNTER M

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/702,030	<b>Applicant(s)</b> KELLY, THOMAS L.	
	<b>Examiner</b> HUNTER M. DREIDAME	<b>Art Unit</b> 3633	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,204,148 to Alexander et al. in view of U.S. Patent 4,747,241 to Whitman.**

**As to claim 1**, Alexander et al. disclose the steps of locating fasteners (20, Fig. 4) in a roof construction (Fig. 4); positioning at least one individual piece of energy absorbing material (3, Fig. 3) to discretely cover each individual fastener of said fasteners whereby said fastener is completely covered by said material; and affixing said material to said fastener (Fig. 5). Although Alexander et al. don't explicitly disclose a method for reducing roof membrane damage from hail/fastener contact, it is inherent through the steps provided and the physical properties of the invention disclosed by Alexander et al. that the method as shown is capable of reducing roof membrane damage from hail/fastener contact.

Alexander et al. don't disclose positioning a roof waterproofing membrane atop all foregoing elements, wherein said roof waterproofing membrane is dimensioned to cover a substantially larger portion of said roof substrate than any of said at least one pieces of energy absorbing layers that are positioned to cover said fasteners.

Whitman discloses a method for protecting roof fasteners, including positioning a roof waterproofing membrane (80A) atop all foregoing elements, wherein said roof waterproofing membrane is dimensioned to cover a substantially larger portion of said roof substrate than any of said at least one pieces of energy absorbing layers that are positioned to cover said fasteners (shown in Fig. 5).

In view of Whitman, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the overlaying membrane of Alexander et al. larger than the other elements as taught by Whitman, as doing so would increase the waterproofing abilities of the cover in that the water would have to go through more layers in order to penetrate the roof.

**As to claim 2**, Alexander et al. disclose a method for reducing roof membrane damage from hail/fastener contact as claimed in Claim 1 wherein said affixing is by adhering (line 11, col. 5).

**As to claim 3**, Alexander et al. disclose a method for reducing roof membrane damage from hail/fastener contact as claimed in Claim 2 wherein said adhering is by a self stick adhesive applied to said energy absorbing material (line 11, col. 5).

**As to claim 4**, Alexander et al. disclose a roof system (Fig. 4) with reduced hail/fastener impact damage characteristics comprising a roof substrate (18, 19, Fig. 4) having one or more layers of material; at least one fastener exposed at a top surface of said substrate; at least one individual piece of dedicated energy absorbing material (3, Fig. 3) positioned to discretely cover each individual fastener of said at least one

fasteners; and a roof waterproofing membrane (2, Fig. 3) positioned atop all foregoing elements.

Alexander do not disclose that said roof waterproofing membrane is dimensioned to cover a substantially larger portion of said roof substrate than any of said at least one pieces of energy absorbing layers that are positioned to cover said fasteners.

Whitman discloses a method for protecting roof fasteners, including positioning a roof waterproofing membrane (80A) atop all foregoing elements, wherein said roof waterproofing membrane is dimensioned to cover a substantially larger portion of said roof substrate than any of said at least one pieces of energy absorbing layers that are positioned to cover said fasteners (shown in Fig. 5).

In view of Whitman, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the overlaying membrane of Alexander et al. larger than the other elements as taught by Whitman, as doing so would increase the waterproofing abilities of the cover in that the water would have to go through more layers in order to penetrate the roof.

**As to claim 5**, Alexander et al disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said one or more layers of material includes insulation (19, Fig. 4).

**As to claim 6**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said energy absorbing material is cover tape (lines 12-2, col. 5).

**As to claim 7**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage

characteristics as claimed in claim 4 wherein said energy absorbing material is a self-sticking cover tape composed of cured ethylene propylene diene monomer (EPDM) membrane (lines 12-26, col. 5) with a butyl gum rubber bottom (lines 12-26, col. 5).

**As to claim 8**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 6 wherein said cover tape is ethylene propylene diene monomer (lines 12-26, col. 5).

**As to claim 9**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 6 wherein said cover tape is self-adhesive tape (line 59, col. 1).

**As to claim 10**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said at least one piece of energy absorbing material is two layers of energy absorbing material (27, 3, Fig. 4).

**As to claim 11**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 10 wherein said two layers comprise a first layer (27, Fig. 4) covering a fastener (20, Fig. 4) and a second layer (3, Fig. 4) covering the first layer and a washer (23, Fig. 4) of the fastener.

**As to claim 12**, Alexander et al. disclose a method for reducing roof membrane damage from hail/fastener contact as claimed in Claim 1 wherein said energy absorbing

material is installed on top of the roof membrane in an area directly over an underlying fastener (shown in Fig. 3).

**As to claim 13**, Alexander et al. disclose a roof system (Fig. 4) with reduced hail/fastener impact damage characteristics comprising a roof substrate (18, 19, Fig. 4) having one or more layers of material; at least one fastener (20, Fig. 4) exposed at a top surface of said substrate; a roof waterproofing membrane (2, Fig. 4) positioned over said at least one fastener; and at least one individual piece of dedicated energy absorbing material (3, Fig. 4) positioned atop all foregoing elements and any waterproofing membrane associated with said roof substrate to discretely cover each individual fastener of said at least one fastener (shown in Fig. 3).

**As to claim 14**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein at least one layer of said energy absorbing material is dimensioned to only cover a fastener head of said at least one fastener (shown in Fig. 3).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNTER M. DREIDAME whose telephone number is (571)272-5177. The examiner can normally be reached on Monday - Friday 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hunter M Dreidame/  
Examiner, Art Unit 3633

/Robert J Canfield/  
Supervisory Patent Examiner, Art Unit 3635